

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John D. Irish et al.
Serial No. : 10/670,703
Filed : September 25, 2003
For : METHODS AND APPARATUS FOR ALLOCATING MEMORY
Examiner : Midys Rojas
Group Art Unit : 2185

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully Submitted,

Dated: January 16, 2009



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ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

In the Final Office Action (dated October 16, 2008), claims 1-34 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication 2001/0011338 by Bonola [hereinafter *Bonola*] in view of Applicants (allegedly) Admitted Prior Art [hereinafter *APA*]. The rejection of claims 1 and 18 is illustrative as to how the rejection is clearly not proper and is without basis.

A. THE REJECTION UNDER 35 U.S.C. § 103 IS CLEARLY NOT PROPER AND IS WITHOUT BASIS AS IT IGNORES EXPRESS CLAIM LANGUAGE SUCH AS "OF THE SIZE REQUIRED" AND "SMALLEST-SIZED GROUP ENTRY NECESSARY"

"When determining whether a claim is obvious, an examiner must make 'a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.'" *In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008) (citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995)). "Thus, 'obviousness requires a suggestion of all limitations in a claim.'" *Id.* (citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)) (emphasis added).

Independent claim 1 recites, *inter alia*
if the memory includes one or more sections of an unallocated size, allocating one of the sections of an unallocated size to the size required by the portion of the set of data thereby creating a section of a dynamically allocated size, the section of the dynamically allocated size including one or more group entries **of the size required** by the portion of the set of data, the dynamically allocated size being the **smallest-sized group entry necessary** to store the portion of the set of data.

Independent claim 18 corresponds generally to independent claim 1 and recites similar features in apparatus form.

Applicants respectfully submit that neither *Bonola* nor the *APA* disclose at least the above features of independent claims 1 and 18, for at least the reasons set forth herein. More particularly, it is submitted that the primary citation to *Bonola* fails to disclose (1) the expressly claimed dynamically allocated size including one or more group entries of the size required by the set of data, and (2) the expressly claimed dynamically allocated size being the smallest-sized group entry necessary to store the portion of the set of data. Accordingly, without conceding the propriety of the proposed combination, the proposed combination of *Bonola* and the *APA* is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Examiner contends that “in interpreting the limitation ‘smallest sized group entry necessary to store the portion of the set of data’, the examiner must consider that this ‘smallest size’ that is ‘necessary’ is a determination that is made by the system that is performing the method of the invention.” *Final Office Action*, page 2. The Examiner goes on, to conclude that regarding “*Bonola*, the smallest size needed is equivalent to a heap sub region that is less than twice the memory required for the application.” *Id.* Applicants respectfully maintain that such an interpretation ignores the terms “smallest” in combination with the term “necessary” for the reasons set forth previously.

Moreover, this rationale fails for a second reason. Such an interpretation completely ignores the expressly claimed language immediately above this feature: “the dynamically allocated size including one or more group entries of the size required by the set of data.” That is, the claims expressly

recite not only "the smallest size... necessary", but that the size is "the size required by the portion of the set of data." In sharp contrast to either of these express claim features on their own, let alone in combination as recited, *Bonola* discloses, at best, larger than the smallest size necessary, and that size being a size that is not the size required.

The secondary citation to the *APA* fails to remedy the above deficiencies in *Bonola*.

For the above-mentioned reasons, Applicants respectfully submit that the rejection is clearly not proper and is without basis. Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

B. CONCLUSION

For at least the reasons herein, Applicants respectfully submit that the rejection is clearly not proper, is without basis, and should be withdrawn. Further, Applicants respectfully request that the Office issue a finding that the application is allowed on the existing claims and that prosecution remains closed.

Respectfully Submitted,

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